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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,778	12/17/2001	Douglas D. Sjostrom	02-35-0385 / 00167-456001	4406
7590 11/21/2003			EXAMINER	
JOEL R. PETROW Smith & Nephew, Inc. 1450 Brooks Road Memphis, TN 38116			NGUYEN, VI X	
			ART UNIT	PAPER NUMBER
			3731	
			DATE MAILED: 11/21/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,778

Applicant(s)

SJOSTROM, DOUGLAS D.

Examiner

Victor X Nguyen

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 08/25/2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 10/015778 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 4-24 are rejected under 35 U.S.C. 102 (b) as being anticipated by Thimsen et al (U.S. 4,844,064).

Thimsen et al disclose in figs 2-5, col. 2, lines 4-40, col. 3, lines 52-67 and col. 4, lines 1-27, a device having all the limitations of claims 1 and 18, including: a cutting instrument (11); an outer member (14) has an opening (16, 17) bounded by a cutting edge (58, 70); a helical knife (18) coupled to the outer member for rotation relative to the outer member. The helical knife (18) has an edge to slide into tissue and the edge extends through the opening (labeled in col. 6, lines 57-68).

Regarding claims 2 and 4, wherein an inner member (44) receives within the outer member. The helical knife (18) is located at a distal end of the inner member; and wherein the inner member (44) defines an aspiration opening (labeled in col.6, lines 36-67).

Regarding claims 5-7, wherein the edge includes a helical edge and the helical knife (18) includes a helical channel (58,70 in fig.3); wherein the helical channel has a pitch that increases

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from the distal end to the proximal end; and wherein the helical channel terminates in an opening through a wall of the inner member.

Regarding claims 8-11, wherein the device further includes a hub (12); wherein the outer member (14) defines a fluid. The cutting edge (58) is located at a distal end of the outer member; and wherein the outer member (14) tapers to the cutting edge.

Regarding claims 12-13, wherein the cutting edge includes a circumferential and a circular in shape (figs. 3-4).

Regarding claims 14-17, wherein the cutting edge is part circumferential, circular and oblong in shape; and wherein the outer member includes a shield portion (fig. 2).

Regarding claims 19-24, wherein the helical knife (18) is on an inner member (44) and the cutting portion is on an outer member (14); wherein transporting the cut tissue along a helical channel defines by the helical knife (18); wherein aspirating the cut tissue is through the inner member; and wherein aspirating fluid is through an opening in the outer member (14).

Claims 1 and 18 are rejected under 35 U.S.C. 102 (b) as being anticipated by Banko (U.S. 4,167,944).

Banko discloses in figs 1-3, col.1, lines 37-46 and col.2, lines 18-24, a device having all the limitations of claims 1 and 18, including: a cutting instrument (10); an outer member (56) has an opening (64) bounded by a cutting edge (37a); a helical knife (37b) coupled to the outer member for rotation relative to the outer member. The helical knife (37b) has an edge to slide into tissue and the edge extends through the opening (labeled in col.3, lines 51-60).

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Thimsen et al (U.S. 4,844,064).

Thimsen et al are explained as before. Although, Thimsen et al do not disclose the inner member and the outer member is in the range of about 0.0005 to 0.002 inches. It would have been obvious matter of design choice to modify the inner member and the outer member is in the range of about 0.0005 to 0.002 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re-Aller, 105 USPQ 233.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 4,867,157 to McGurk-Burleson

U.S. Pat. No. 4,203,444 to Bonnell


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-3982.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Victor X Nguyen ✓
Examiner

11/07/03


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
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